

REMARKS/ARGUMENTS

Reconsideration and allowance of this application are respectfully requested.

Currently, claims 57-70, 83-89, 101, 103 and 109-131 are pending in this application.

Rejection Under 35 U.S.C. §102:

Claims 57-106 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Sims, III (U.S. '011, hereinafter "Sims"). Applicant respectfully traverses this rejection with respect to still pending claims 57-70, 83-89, 101 and 103.

Section 37 of the Office Action states the following:

"The Applicant states that the priority date of August 5, 1998 is not the priority date of the reference (6,550,011). The Examiner disagrees with the Applicant. The reference 6,550,011, has a priority date of August 5, 1998 as this continuation in part reference qualifies as prior art. Thus this point is moot."

The U.S. filing date of Sims (U.S. '011) is after the U.S. filing date of the present application. Only those portions of Sims (U.S. '011) that are properly supported by parent application no. 09/129,370 (now U.S. Patent No. 6,438,235) are entitled to its August 5, 1998 filing date. Section 37's general allegation that "The reference 6,550,011 has a priority date of August 5, 1998..." is thus erroneous for those portions of Sims that are not supported by the parent application. Indeed, MPEP §2136.03 explicitly states, *inter alia*, "In addition, the subject matter relied upon in the rejection must be disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph, in order to give that subject matter the benefit of the earlier filing date under 35 U.S.C. 102(e)."¹

¹ Similarly, MPEP §2136 further states "The 35 U.S.C. §102(e) critical date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph (emphasis added)."

Accordingly, those portions of Sims which are not supported under 35 U.S.C. §112, first paragraph, by parent application no. 09/129,370 are not entitled to its August 5, 1998 filing date and thus do not qualify as prior art against the present application. There are numerous portions in Sims relied upon in the rejection that are not supported under 35 U.S.C. §112, first paragraph, by the parent application and are thus not entitled to the August 5, 1998 filing date. For example, not all of the serial copy management rules disclosed in col. 15, lines 4-45 (specifically identified and relied upon in the rejection in section 39 of the Office Action) of Sims are supported under 35 U.S.C. §112, first paragraph, by the parent application. These unsupported portions are not entitled to the parent application's August 5, 1998 filing date and thus do not qualify as prior art. If the next Office Action maintains the rejection in view of Sims, Applicant respectfully requests that the next Office Action specifically point out where in the parent application the subject matter being relied upon in the rejection is disclosed.

For a reference to anticipate a claim, each element must be found, either expressly or under principles of inherency, in the reference. Each element of the claimed invention is not found in Sims. For example, Sims fails to disclose "receiving a transfer authorization request having an indicator of the first device, an indicator of the second device, and an indicator of the protected electronic content; [and] updating a first device history table to indicate that the first device is not authorized to render the protected electronic content and updating a second device history table to indicate that second device is authorized to render the protected electronic content based on the received transfer authorization request (emphasis added)," as required by independent claim 57. Independent claim 83 and its dependents require similar features. Similar, but not necessarily identical, comments apply to new claims 109-131.

Section 38 of the Office Action states “The host device request the destination device’s public key in order to confirm the identity of the device authorized by the content provider (see col. 17, lines 1-9). The indicators are the keys that the devices possess.” However, the claimed transfer authorization request is not disclosed by Sims’ disclosure of a public key. That is, a public key does not anticipate or even render obvious a transfer authorization request. Moreover, even assuming *arguendo* that the public key did provide an indication of a device, the transfer authorization request as claimed requires an indication of a first device, an indication of a second device and an indicator of the protected electronic content. Accordingly, even assuming *arguendo* that the public key discloses an indicator of a second (first) device, the public key would still not provide an indicator of the first (second) device and/or an indicator of the protected electronic content. Indeed, the public key would be used to protect electronic content, but is not an indicator of the protected content itself.

Section 39 of the Office Action apparently alleges that the claimed first device history table and the claimed second device history table is disclosed by Sims’ disclosure of a list of acceptable users. Even assuming *arguendo* that this argument is accepted, there is no teaching or disclosure of an update of the acceptable users list disclosed in Sims to reflect a transfer of authorization. That is, Sims fails to disclose “updating a first device history table to indicate that the first device is not authorized to render the protected electronic content and updating a second device history table to indicate that the second device is authorized to render the protected electronic content based on the received transfer authorization request (emphasis added),” as required by claim 57. Similar comments apply to independent claim 83 and its dependents.

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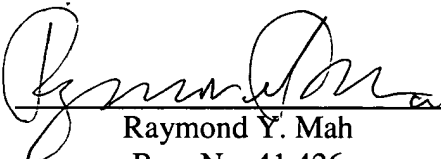
Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C.
§102 in view of Sims be withdrawn.

Conclusion:

Applicant believes that this entire application is in condition for allowance and respectfully requests a notice to this effect. If the Examiner has any questions or believes that an interview would further prosecution of this application, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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